REMARKS/ARGUMENTS

Upon entry of the instant amendment, Claims 1-23 and 25-26 will be pending. Claim 24 has been canceled. No amendments to the pending Claims 1-23 or 25-26 are presented.

Objection to the Specification

The Office Action at Paragraph 1 objected to the disclosure as containing an embedded hyperlink or a browser-executable code. The Specification has been amended to change "www.netsuite.com" to "www-netsuite-com" and to change "www.salesforce.com" to "www-salesforce-com." It is believed that these revised expressions, in which the ASCII dots are replaced with ASCII dashes, would likely not be treated as hyperlinks or executable code by browsers or other automated systems, and are thus compliant with the requirements of MPEP 608.01.

Rejections Under 35 U.S.C. § 103(a)

The Office Action rejected Claims 1-25 under 35 U.S.C. § 103(a) as being unpatentable over Knox, et. al. US 2007/0005762A1 (hereinafter "Knox") in view of Weber, et. al. US 5878230 (hereinafter "Weber"). Applicants earnestly request reconsideration of these rejections in view of the remarks hereinbelow.

I.   Introduction

Although Applicants are mindful that *claim language* is indeed the critical factor in defining the scope of the present invention over cited references, consideration of the following introductory remarks would be appreciated. Knox and Weber (collectively, the "cited references") stand for the general proposition that certain conceptual building blocks used by the claimed invention already existed in the prior art as of the March 8, 2004 filing date of the instant patent application. Consistent with the shoulders-of-giants principle upon which virtually all technological progress is based, Applicants certainly admit that certain claimed components, such as basic REPLY-TO principles, are indeed

disclosed in the cited references. However, cited references fail to teach or suggest either (i) the particular objective of the presently claimed invention, including the particular environment in which it is achieved, or (ii) the particular manner in which that particular objective is achieved by the presently claimed invention.

Knox teaches that an outgoing e-mail from a sender can be "intercepted" by a "mail enhancement server" (Knox at [0016]), and that the mail enhancement server can modify a hyperlink in that e-mail message to embed a tracking code therein (Knox at [0018), or can embed an image call in that e-mail message with the tracking code (Knox at [0019]). The mail enhancement server also sends the tracking code to a predetermined web server (logging server, Knox at [0026]) that is a destination of the hyperlink or image call in that e-mail message. If the hyperlink is clicked by the recipient, or if the recipient's e-mail system fetches the image call upon message opening (Knox at [0020]), the recipient's behavior responsive to that received e-mail then becomes known to the logging server by virtue of the embedded tracking code and can therefore be tracked and logged. Weber teaches that an outgoing e-mail from a sender to a recipient can contain an Interchange Document Profile (IDP) that includes a "reply to" override field, and that the contents of that "reply to" override field can be placed in the "to" field of a reply from the recipient instead of the sender's e-mail address (Weber at col. 5, lines 8-22).

As pointed out in the instant specification, the claimed invention is applicable for a particular environment in which a particular person – a user of a web-based business information system – possesses two distinct e-mail accounts associated with two distinct e-mail systems: a first account on an internal e-mail facility of the web-based business information system, and a second account on a "native" e-mail system. That person (termed "end user" herein and in the relevant pending claims) engages in e-mail communications with a second person (termed "external contact" herein and in the relevant pending claims), such as a customer or vendor, who has their own account on their own e-mail system.

As pointed out in the instant specification, a problematic conflict can arise because the end user often desires to use his/her native e-mail system much of the time to communicate with the external contact, while at the same time it is desired for the web-based business information system to track those communications as if they were to and from the internal mail facility account of the end user. This problematic conflict is exacerbated by the fact that the native e-mail system of the end user, as well as the e-mail system of the external contact, are usually *beyond the control* of the company that runs the web-based business information system. Therefore, any desirable solution to the problem should not presume any special capabilities, or require any special software installations or system modifications, of the native e-mail server of the end user or of the e-mail server of the external contact. Advantageously, the presently claimed invention only requires the bare bones REPLY-TO capability of IETF RFC 2822 at native e-mail system of the end user and the e-mail system of the external contact to provide a resolution for the above-described problematic conflicts. Stated another way, the presently claimed invention achieves the goal of allowing a web-based business information system (with the cooperation of the end user) to "insert itself" into the end user's e-mail communication threads, while still remaining within the confines of the commercially dominant way that e-mails are treated by external e-mail systems, and while allowing the end user to continue use of their preferred external e-mail system.

In contrast, it could not be found where Knox or Weber teach or suggest the particular environment of a web-based business information system having an internal mail facility that needs to harmonize itself with two external e-mail systems to track communications therebetween, especially where the two external e-mail systems are not under common control with the web-based business information system and are not assumed to have any ultra-RFC 2822 capabilities. Moreover, the cited references fail to teach or suggest the particular manner in which the above-described objectives are achieved in the above-described environment. Indeed, as detailed further below, even where the Office Action selects various teachings from Knox and Weber and combines them together in hindsight using the presently claimed invention as a template, each

pending claim continues to recite one or more elements not identified by the Office Action in either of Knox or Weber.

II.   Claim 1

Turning now to the particular language of Claim 1 in comparison to the cited references, it could not be found in Knox or Weber "wherein a domain of a REPLY-TO field of said initial e-mail message corresponds to a domain of said internal e-mail facility, and wherein a local part of said REPLY-TO field of said initial e-mail message comprises a tracking string encoding tracking information associated with said end user and said external contact with respect to said web-based business information system."

With regard to the domain of the REPLY-TO field, the Office Action states in paragraph 7 that, in Knox, it is "inherent, the reply-to field necessarily matches the address (which includes a domain)." However, as evidenced by IETF RFC 2822 (which is of record in the present application, see IDS dated June 10, 2005) at Section 3.6.2, it is not inherent that the reply-to field be populated with anything at all, since it is an optional field. Similar comments are applicable to Weber which, like RFC 2822, teaches that there can be a reply-to field, but specifies that the reply-to field can be to "a variety of third party recipients." Furthermore, there is certainly no teaching or suggestion specifying a domain of the REPLY-TO field for an "initial e-mail message" from an "internal e-mail facility" of a "web-based business information system" in the scenario recited in Claim 1 in which there is an internal e-mail facility and a distinct "native e-mail system" of the end user of the web-based business information system.

More importantly, with regard to the local part of the REPLY-TO field, it is respectfully submitted that the Office Action contains critical error where it is stated:

> Neither Knox nor Weber disclose that the "tracking string
> encoding tracking information" or "a first modified version of
> said tracking string" is "a local part of said REPLY-TO field"
> but this would have been obvious to one of ordinary skill in

> the art at the time of the invention. Knox teaches inserting
> the tracking string into a hyperlink (paragraph 18), clicking
> on a reply-to button is similar to clicking on a hyperlink the
> only difference being instead of a webpage an email opens.
> Thus placing the tracking string in the reply-to field is similar
> to placing it in a hyperlink which is well known. . . (Office
> Action at Paragraph 5)

Hyperlinks embedded in an e-mail, as disclosed in Knox, are both conceptually and functionally distinct from REPLY-TO fields of an e-mail as recited in Claim 1. It is well known that entirely different functionalities -- usually instantiation of a browser window -- are invoked when a hyperlink is clicked by the recipient as compared to when the recipient presses a "reply" button, which simply opens a return e-mail and populates to the "to" field for the user. Substantially more capability is usually required at the receiver's computer upon clicking the hyperlink (e.g., the presence of a browser integrated with the e-mail software) than for a "reply" button, which only requires bare-bones compliance with RFC 2822 (or similar e-mail standard). Especially as discussed in Knox, the user's click on a hyperlink is not associated with a reply to the sender, but rather for accessing the website pointed to by the hyperlink. Nowhere in Knox is an e-mail reply message disclosed in any form (the word "reply" could not be found anywhere in the text of Knox), and certainly nowhere is there a pre-specification of a reply-to address for such communications as recited in Claim 1. Nowhere in Knox is there disclosed an objective of, or a method for, tracking an e-mail thread (i.e., a back-and-forth e-mail communication) between the sender and the recipient. Rather, Knox is directed to the substantially different objectives of detecting whether the user opened the received e-mail, and detecting whether they went to a particular web site responsive to that e-mail. Accordingly, it would not have been obvious for a person skilled in the art at the time of the invention, based on the substantially different scheme disclosed in Knox that is directed to substantially different endeavors, to have "a local part of said REPLY-TO field

of said initial e-mail message" that comprises "a tracking string encoding tracking information associated with said end user and said external contact with respect to said web-based business information system" as recited in Claim 1. The teachings of Weber are likewise inapposite, because Weber (filed in 1995) simply teaches the basic existence a REPLY-TO field, standing for nothing more than a subset of contents of IETF RFC 2822.
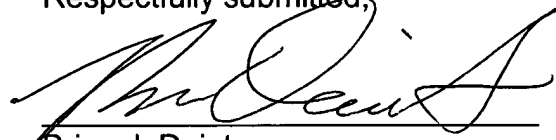
Furthermore, nowhere could it found in Knox or Weber, "sending a modified version of said first reply e-mail message to a native e-mail address of the end user" in which there is a "REPLY-TO field . . . wherein a local part of said REPLY-TO field comprises a first modified version of said tracking string." Unlike Knox, Weber, or any combination thereof, the present invention as recited in Claim 1 provides the ability for the web-based information system (with the cooperation of the end user of the web based business information system) to unilaterally harmonize itself with two external e-mail systems to track an e-mail communication thread between the end user and the external contact, while neither requiring control over the external e-mail systems nor assuming any special capabilities thereof outside of the bare-bones RFC 2822, by leveraging a unique and nonobvious combination of the recited messaging path (e.g., such that the web-based business information system is acting as an intermediary between the native e-mail system and the external contact) and the recited population of the local-part and domain fields of the REPLY-TO addresses, which are known to be treated in certain ways by any external e-mail systems compliant with RFC 2822. It would not have been obvious for a person skilled in the art at the time of the invention, based on the substantially different scheme disclosed in Knox that is directed to substantially different endeavors, to have a "REPLY-TO field . . . wherein a local part of said REPLY-TO field comprises a first modified version of said tracking string" as recited in Claim 1.

III.   Claims 2-23 and 25-26

Independent Claim 15 is submitted as being allowable for reasons similar to those presented *supra* with respect to Claim 1, the primary language difference being that "reply-designating header field" is included in place of "REPLY-TO field" to fairly encompass, *inter alia*, scenarios in which terminology variations might be introduced by specifications subsequent to RFC 2822 or by other specifications analogous in spirit and intent to RFC 2822 with respect to the REPLY-TO field. Independent Claim 20 is submitted as being allowable for reasons similar to those presented *supra* with respect to Claim 15, the primary difference being that, instead of being located in the local part of a reply-designating header field in the initial e-mail message (and modified version of the first reply e-mail message), the tracking string (and modified tracking string(s)) is (are) located in one or more "thread-recurrent fields" that, in accordance with the instant specification at [0077], refers a field that is not changed, stripped away, or otherwise substantially disturbed by most common e-mail systems when their "reply" functions are used. Dependent claims 2-14, 16-19, 21-23, and 25-26 are submitted as being allowable for at least the reason that they depend from an allowable base claim.

Entry of this amendment and allowance of this application are respectfully requested. If a telephone interview could advance the prosecution of this application, the Examiner is invited to contact the undersigned at the below-listed telephone number. At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 50-3014 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 50-3014 under 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees.

Respectfully submitted,

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Brian J. Daiuto
Reg. No. 38,422
Attorney for Applicants

LAW OFFICE OF BRIAN J. DAIUTO
886 ILIMA COURT
PALO ALTO, CA 94306

Telephone calls may be made to:
    (650) 565-8081